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10/523,153	10/06/2005	Nicholas Rowland Bird	83950	8686
7590 04/13/2009 Fitch Even Tabin & Flannery 120 South LaSalle Street Suite 1600 Chicago, IL 60603-3406				
EXAMINER				
PARK, CHAN S				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/523,153

Applicant(s)

BIRD ET AL.

Examiner

CHAN S. PARK

Art Unit

2625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

1. **Claims 1-11 and 34** are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent¹ and recent Federal Circuit decisions² indicate that a statutory "process" under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claim recites a series of steps or acts to be performed, the claim neither transforms underlying subject matter nor is positively tied to another statutory category that accomplishes the claimed method steps, and therefore does not qualify as a statutory process. For example the method including the steps of receiving and transmitting is of sufficient breadth that it would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine. The applicant has provided no explicit and deliberate definition of "receiving" or "transmitting" to limit the steps to the electronic form of communication (surface mail), and the claim language itself is sufficiently broad to read on a person being shown a printout of information,

¹ *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

² *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

mentally determining/specifying the one of delivery media to be a surface mail, and physically carrying/mailing the document to the said recipients.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 34-36** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite the limitation of "said method substantially as herein disclosed with reference to any one of Figs. 1-10 of the accompanying drawings." It is unclear as to what the scope of "any one of Figs. 1-10 of the accompanying drawings."

Claims 5, 16 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite the step of "selecting a merging process for said document template type". It is unclear as to exactly what is being merged with what. Furthermore, it is unclear if there is any difference between "template document" and "document template type". Clarification/explanation from the Specification is requested.

Claims 6, 17 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite the limitation of "said

respective merging process". It is unclear if this merging process is referring to the merging performed in claim 4 or claim 5. Or are they simply the same?

Clarification/explanation from the Specification is requested.

Claims 11, 22 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite the limitation of "said delivery media type including one or more new media types". It is unclear if the new media types are one of transmission methods or the physical documents to be transmitted. Clarification/explanation from the Specification is requested.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 2, 7-13, 18-24 and 29-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Linde U.S. Patent Application Pub. No. 2002/0184086.

With respect to claim 1, Linde discloses a method for bulk communication of information to recipients via multiple delivery media including facsimile, email, surface mail, and SMS messaging (fig. 1), said method including the steps of:

receiving via a single interface information for distribution including information regarding recipients (receiving the subscriber preference information in paragraph 30);
and

transmitting at least one document based on said received information using a specified one of said delivery media for each of said recipients based on said recipients' delivery preferences (paragraphs 34 & 38).

With respect to claim 2, Linde discloses the method according to claim 1, further including the step of escalating transmission of said at least one document using a different one of said delivery media for each of one or more of said recipients for whom transmission by said specified delivery media fails (paragraph 38, lines 18-24).

With respect to claim 7, Linde discloses the method according to claim 2, further including the steps of:

converting said at least one document into a format suitable for said specified one or different one of delivery media for each recipient (note that the document must be converted into a specified format in order to transmit to the document via email or facsimile communications); and

sending said formatted document to a carrier for transmission using said specified one or said different one of said delivery media (paragraph 35).

With respect to claim 8, Linde discloses the method according to claim 7, further including the step of processing a report from said carrier regarding said transmission to provide status information regarding delivery of said document to each recipient (receiving the fail notice in paragraph 38, lines 18-34).

With respect to claim 9, Linde discloses the method according to claim 8, wherein said escalating step is dependent upon said status information (paragraph 38, lines 18-34)..

With respect to claim 10, Linde discloses the method according to claim 1, wherein said delivery media includes archiving (note that all emails are archived until the user specifically deletes the emails).

With respect to claim 11, Linde discloses the method according to claim 1, wherein said delivery media includes one or more new media types (PDA transmission in paragraph 35).

With respect to claims 12, 23 and 34-36, arguments analogous to those presented for claim 1, are applicable.

With respect to claims 13 and 24, arguments analogous to those presented for claim 2, are applicable.

With respect to claims 18 and 29, arguments analogous to those presented for claim 7, are applicable.

With respect to claims 19 and 30, arguments analogous to those presented for claim 8, are applicable.

With respect to claims 20 and 31, arguments analogous to those presented for claim 9, are applicable.

With respect to claims 21 and 32, arguments analogous to those presented for claim 10, are applicable.

With respect to claims 22 and 33, arguments analogous to those presented for claim 11, are applicable.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linde as applied to claim 1 above, and further in view of Powers U.S. Patent No. 6,446,115.

With respect to claim 3, Linde teaches the method according to claim 1, wherein said received information includes data specific to each recipient (paragraph 41).

Linde, however, does not explicitly teach that the received information includes one or more template documents.

Powers, the same field of endeavor of the bulk communication, teaches the method of receiving recipient information including one or more templates documents and data specific to each recipient (fig. 3C).

At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the communication method of Linde to include the step of receiving the one or more templates documents as taught by Powers.

The suggestion/motivation for doing so would have been to automatically populate the corresponding template with the document contents in accordance with the user's preferences.

Therefore, it would have been obvious to combine Linde with Powers to obtain in the invention as specified in claim 3.

With respect to claim 4, the combination teaches the method according to claim 3, further including the step of merging said one or more template documents and said data specific to each recipient to provide said at least one document for each of said recipients (fig. 3C of Powers and paragraph 41 of Linde).

With respect to claim 5, the combination teaches the method according to claim 4, further including the steps of determining a document template type for each delivery media and selecting a merging process for said document template type (fig. 3C of Powers and paragraph 41 of Linde).

With respect to claim 6, the combination teaches the method according to claim 5, wherein said data specific to each recipient is provided to said respective merging process (fig. 3C of Powers and paragraph 41 of Linde).

5. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linde as applied to claim 12 above, and further in view of Powers.

With respect to claims 14-17, arguments analogous to those presented for claim 3-6, are applicable.

6. Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Linde as applied to claim 12 above, and further in view of Powers.

With respect to claims 25-28, arguments analogous to those presented for claim 3-6, are applicable.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571)272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CHAN S PARK/
Primary Examiner, Art Unit 2625

April 9, 2009